

## REMARKS

The following remarks are submitted in response to the Office Action mailed July 22, 2003. Claims 3, 47-51, 60, 108-112, and 116 were withdrawn from consideration, and claims 1, 2, 4-46, 52-59, 61-107, 113-115 and 117-150 are pending and remain under consideration. With this Amendment, claims 14, 57, and 148 have been cancelled. No new matter has been added. Reconsideration, reexamination and allowance of the pending claims is respectfully requested.

### **Power of Attorney**

Applicants enclose herewith a Revocation and Power of Attorney form.

### **Amendments to the Specification**

Clarifying amendments have been made to the specification primarily to correct typographical errors in reference numbering. No new matter has been added.

### **The Objected to Drawings**

In paragraph 3 of the Office Action, the Examiner objects to Figure 23B. The examiner correctly notes that element number 228 is missing from the figure. Applicants respectfully submit an amended Figure 23B properly identifying missing element number 228.

### **Other Miscellaneous Objections**

In paragraph 4 of the Office Action, the Examiner objects to claims 52, 56-57 and 146 because of various claim language informalities. The Applicants have reviewed and amended the claims to correct the informalities noted by the Examiner.

**The 35 U.S.C. § 112 Claim Rejections**

In paragraphs 5 and 6 of the Office Action, the Examiner rejects claims 22 and 85 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully disagree.

Applicants submit that rejected claims 22 and 85 are properly constructed Markush claims. Markush claims may be used to indicate alternative embodiments of an invention that may be selected from a defined group of examples or preferences. The items in the group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. See MPEP 2173.05(h).

The fundamental principle in using Markush groups is to limit the examples to a defined and finite group that will be considered definite. Applicants respectfully submit that claims 22 and 85 are definite as to their scope using the permissible Markush language “and mixtures thereof.”

Additionally, mere breadth of a claim is not to be equated with indefiniteness. See MPEP 2173.04. The subject matter of claims 22 and 85 is clear to one of skill in the art, as encompassing one of the listed materials, or mixtures of the materials. Applicants submit that the skilled artisan would know that mixtures of these types of materials are commonly used, and would comprehend the various mixtures suitable for use in the implantable cardioverter-defibrillator. As such, it is believed that claims 22 and 85 meet the requirements of 35 U.S.C. §112, second paragraph.

### The 35 U.S.C. § 102 Claim Rejections

In paragraphs 7 and 8 of the Office Action, the Examiner rejects claims 1, 2, 4, 14, 16-25, 31, 37-40, 42 and 43 under 35 U.S.C. §102(b) as being anticipated by Hauser et al. (U.S. Patent No. 5,385,574). Applicants respectfully traverse this rejection.

Applicants have amended claim 1 to further include the limitations recited in Applicants' pending claim 14, now canceled, and recited in Applicants' specification on pages 50 through 56. The newly added limitations are further illustrated in Applicants' Figure 23A and Figure 23B.

The Hauser et al. reference fails to teach a housing having a top surface, a bottom surface, a proximal end and a distal end, wherein the housing is substantially bilaterally symmetrical along the length of the housing's top surface, and further wherein the width at the distal end of the top surface of the housing is less than the width at the proximal end of the top surface of the housing. The Examiner asserts that, when looking at the figures of Hauser et al., the top end is considered the distal end and the bottom end is considered the proximal end. In this configuration, the top surface of the device of Hauser et al. is either the front or back in the figure, in which case it is not bilaterally symmetrical along the length, or it is the left or right side, in which case the top surface does not have differing widths at the distal and proximal ends. Therefore, regardless of what side of the Hauser et al. device is considered the top surface, the reference fails to teach all of the claimed features of the present invention. Withdrawal of the rejection is respectfully requested. With the entering of this amendment, it is believed that independent claim 1, and the claims depending there from (including claims 2, 4, 14, 16-25, 31, 37-40, 42 and 43) are now in condition for allowance.

In paragraph 9 of the Office Action, the Examiner rejects claims 52, 55-57, 59, 61, 71, 75-78, 82, 83, 86, 92, 100 and 104 under 35 U.S.C. §102(b) as being anticipated by Adams in

U.S. Patent No. 5,601,607 (U.S. Patent No. 5,385,574). Applicants respectfully traverse this rejection.

Applicants have amended claim 52 to indicate that the distal housing section is contiguous with the main housing section, and further wherein the distal housing section has a width less than the width of the main housing section.

In column 5, lines 13 through 18, Adams recites that "Fig. 7 illustrates a side view of a pulse generator (PG) 72, including a plurality of faces..., having an insulating layer 74, that covers a significant fraction of the exterior surface of the PG 72, leaving the balance 76 ... of the exterior surface of the pulse generator 72 in the form of exposed metal to serve as an electrode." — Surface As such, the Adams reference does not teach both a main housing section contiguous with a distal housing section wherein the distal housing section has a width less than the width of the main housing section. The Adams reference teaches a main housing member (or PG 72) having an insulating layer disposed over a portion of that member. Moreover, the Adams reference shows how the PG 72, itself, does not change in shape or size. *irrelevant whether it is the housing or insulation*

Claim 52, in contrast, recites two housing sections. The distal housing section has a width less than the main housing section, independent of any coating disposed along the length of the implantable cardioverter-defibrillator. Additionally, in claim 52, the electrode is located on the distal housing member. In the rejection, the Examiner refers to the same part of the Adams device (76, 84) for both the distal housing member and the electrode. If one were to equate the electrode (76, 84) of Adams with the presently claimed distal housing member, then *yes it does* Adams fails to teach an electrode on the housing. Alternatively, if the electrode of Adams is equated with the presently claimed electrode, then Adams fails to teach a distal housing member with a width less than the main housing member. Either way, the Adams reference fails to

teach all of the claimed features. Withdrawal of the rejection is respectfully requested. Claims 55-56, 59, 61, 71, 75-78, 82, 83, 86, 92, 100 and 104 depend from claim 52. In view of the above, Applicants respectfully submit that claims 52, 55-56, 59, 61, 71, 75-78, 82, 83, 86, 92, 100 and 104 are in condition for allowance.

### **The 35 U.S.C. § 103 Claim Rejections**

In paragraphs 10-27 of the Office Action, the Examiner rejects claims dependent on independent claims 1 and 52 under 35 U.S.C. §103(a) as being unpatentable over various references. Applicants respectfully traverse these rejections. Applicants note that the claims that the Examiner rejects are dependent on either independent claim 1 or 52, which are believed to be in condition for allowance for the reasons set forth above. As such, the dependent claims are also believed to be in condition for allowance. Additionally, none of the secondary references cited by the Examiner provide what the primary references, Hauser et al. and Adams, fail to teach.

In paragraphs 28-32 of the Office Action, the Examiner rejects independent claim 113 and several dependent claims therefrom under U.S.C. §103(a) as being unpatentable over various references. Applicants respectfully traverse these rejections.

However, in paragraph 33 of the Office Action, the Examiner indicated that dependent claims 143-144, 146, and 148 would be allowable if rewritten in independent form including all of the limitations the base claim and any intervening claims. Therefore, applicants have rewritten claims 143, 144 and 146 in independent form including all of the limitations the base claim and any intervening claim. Additionally, applicants have taken the language of claim 148 and incorporated it into independent claim 113, while canceling claim 148. Therefore, claims

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113, 143, 144, and 146, and any claims dependent there from, are now in condition for allowance.

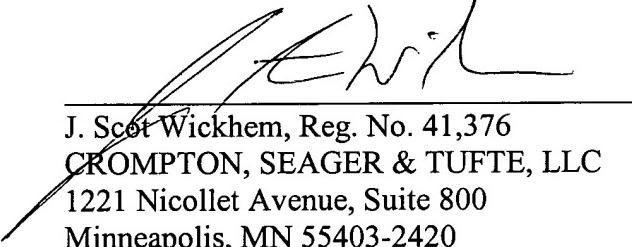
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,

Date: 22 January 2004

  
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